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09/808,357	03/15/2001	Hiroki Ichiki	1080.1093/JDH	3419

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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 11/26/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/808,357

Applicant(s)

ICHIKI ET AL.

Examiner

Marc R Filipczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

***Response to Amendment***

This action is responsive to Applicant's response filed on August 18, 2003 (paper # 4) in which claims 1-5 remain for examination and newly added claims 6-11 are presented herein.

***Drawings***

Figures 1, 2 and 3 remain objected to because they must be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The subject matter, "push-program received by a web server executes and detects changes in information provided to web browsers by its respective web server by comparing current information available from the respective web server with previous information available from the respective web server" and "pushing to the mediator program indicia of the differences" were not described in the

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specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention.

Claims 10 and 11 depend from 9 therefore contain the deficiencies of that claim.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 2, the term “topical” is indefinite. What is topical information? Second, the phrase, “ from a user’s client” is indefinite. What is user’s client?

Regarding claims 3-5 depend from claim 1 and therefore contain informalities and inconsistencies of that claim.

Regarding claims 6, 7 and 9, the terms “topical” and “indicia” are indefinite. What is topical information? Further regarding claim 9, the phrase “program indicia of the differences” is indefinite. What is the program indicia of the differences and how is it determined?

Regarding claim 8, the term “topical” is indefinite. What is topical information? Second, “server” and “source server” are indefinite because it is unclear what the difference between them is?

Regarding claims 3-5, 10 and 11 depend from claims 1 and 9 respectively and therefore contain the deficiencies of those claims.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 9-11 are rejected as best as the Examiner is able to ascertain under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) in view of Skinner et al (U.S. Patent No. 6,085,198).

Regarding claims 1 and 9-11, AAPA discloses an information providing system comprising: (fig. 3, AAPA)

a plurality of information sources, each having an information providing function, and outputting an individual index; (fig. 3, items 2, 6 and 8, AAPA)

a retrieval engine having an index construction function, and an information retrieval function (fig. 3, items 3 and 4, AAPA), but does not teach a mediating apparatus.

However, Skinner discloses an integrated three-tier application framework with automated class and table generation (title and abstract, Skinner) wherein a mediator (fig. 2, items 210 and 216, *server*, Skinner) along with a retrieval engine (fig. 3, items 202 and 206, *browser*) and plurality of information sources (fig. 3, items 212 and 218, *database server*, Skinner) is used to generate data classes.

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Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified AAPA indexing system in view of Skinner by applying the mediator (application server) to serve as a middle ware in the AAPA system and interact between retrieval engines and information servers. One of ordinary skill in the art would have been motivated to use a mediator in the AAPA system because Skinner's mediator is implemented to work with indexes as disclosed by Skinner.

(Note: metadata used in Skinner is an index).

Claims 2-8 are rejected as best as the Examiner is able to ascertain under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. (U.S. Patent No. 6,085,198) in view of Applicant Admitted Prior Art (AAPA).

Regarding claims 2-8, Skinner discloses a receiving section for receiving a plurality of indexes outputted by a plurality of information sources (fig. 2, items 210, 212 and 214, Skinner);

(Note: database server retrieves metadata which are indexes)

an index selection section for selecting an individual index satisfying a predetermined index selection condition from indexes received by the receiving section (fig. 5B, block 505, *MetaParameter*, and fig. 7A, block 700, Skinner); and

an index sending section for sending the selected index to a retrieval engine (fig. 2, items 210, 204 and 206, Skinner) for use in an index construction function, where the retrieval engine receiving at least one index constructs a general index (fig. 9, items 300A (client), 903 (generated code, metadata on client site), Skinner).

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Skinner discloses a “generic” version of the mediator taught by the Applicant, however, specific details of all the sections of Applicant’s mediator in light of the specification and the handling of a push program are not taught by Skinner. Still, having the Skinner reference in view of the AAPA system the Applicant is improving, Examiner asserts it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Skinner system with the AAPA system and derive with a mediator that performs all the functions disclosed by the Applicant including the handling of a push program (fig. 3, item 6, AAPA) from multiple data sources. This would have been accomplished because Skinner’s middle ware positioned in the AAPA system would automatically receive push programs from servers (fig. 3, AAPA). One would have been motivated to use Skinner system in view of AAPA because the middle ware disclosed and taught by Skinner handles the selecting, retrieving and sending of indexes (data) accordingly, and that is what the AAPA system lacks and needs, and the implementation of the Skinner system in view of AAPA could have been accomplished with minimal configuration changes to the middle ware.

### ***Response to Arguments***

Applicant’s arguments filed on August 18, 2003 have been fully considered but they are not persuasive. The arguments and responses are listed below. (Applicant’s amendment has not been numbered)

Examiner reminds the Applicants to:

In order to expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most

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specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Applicant argues in the 8/18/03 response under the heading **change to figure 3** that, “the push concept in fig. 3 was mistakenly thought to be prior art” and “the inventors are willing to provide a declaration that the subject matter of Fig. 3 is derived from the inventors”.

In response to Applicant’s argument, Examiner disagrees. If the inventors mistakenly described fig. 3 as prior art and desired to disclose fig. 3 as part of the invention, then the Applicants should have provided a declaration providing such evidence to support that which is claimed. Hence, the Examiner interprets the disclosure and all the bodies of the specification as they have been written, thus fig. 3 is considered prior art. Finally, absent to the contrary the Examiner considers the specification as originally filed, and attorney’s arguments cannot correct deficiencies in this specification.

Applicant argues in the 8/18/03 response under the heading (... Burrows, Skinner) information regarding Burrows.

In response to Applicant’s argument, Examiner disagrees. Burrows is not relied upon in the rejection thus is irrelevant.

Applicant argues in the last two pages of the 8/18/03 response that, “metadata does not exist in Skinner’s Run Time Environment; the Run Time Environment being the time when users



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operate the system to store, delete, and retrieve data in the database". Further, Applicants point to fig. 9 of Skinner to further support their view.

In response to Applicant's argument, Examiner disagrees. It appears that the Applicants have misinterpreted Skinner system. Fig. 9, Skinner discloses an application server (middle tier) that interacts with the client including update management (304A) and a query management (312A) based on metadata (900, 902, 903 and 905) at run time environment. Also, Examiner points Applicants to col. 13, lines 9-28, where many different types of data are discussed including indices. Every relational database contains indices.

With respect to all the pending claims 1-11, Examiner respectfully traverses Applicant's assertion based on the discussion cited above, as such, Examiner maintains the same rejection.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156.


The examiner can normally be reached on Mon-Fri, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MF

November 25, 2003



SAFET METJAHIC  
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